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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 10/825,987  | 04/16/2004  | Najib Khan Suratte   | 2000 P 20688 US             | 8727             |
| 48154   | 7590        | 12/07/2006           |                             |                  |
| SLATER & MATSIL LLP<br>17950 PRESTON ROAD<br>SUITE 1000<br>DALLAS, TX 75252 |             |                      | EXAMINER<br>GEHMAN, BRYON P |                  |
|   |             |                      | ART UNIT<br>3728            | PAPER NUMBER     |

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/825,987

Applicant(s)

SURATTEE ET AL.

Examiner

Bryon P. Gehman

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-16 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-16 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/26/06, 9/22/06</u> | 6) <input type="checkbox"/> Other: _____  |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9 and 11-14 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Duncan (5,293,996). Disclosed is a bag comprising first and second side walls (top and bottom sheets) attached at three edges (21-23), a portion of the first wall comprising transparent material (15), a moisture indicating material (16) mounted within the bag adjacent the transparent material, a porous inner bag (13) and a desiccant material (31) located in the porous bag.

As to claims 11 and 12, see column 2, lines 49-62.

As to claim 13, see column 2, lines 4-24.

As to claim 14, see column 1, lines 7-26.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 10 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan. Duncan employs a desiccant material, silica gel being officially noted to an old and well-known desiccant material commonly used in desiccant packaging.

5. Claims 1, 3-8 and 21-23 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Neteler (6,531,197) in view of Duncan. Claims 1, 3-7, 15 and 21-23 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Neteler (6,531,197) in view of Williams et al.. Neteler discloses a bag (10) comprising side walls substantially impervious to moisture and having an opening (14) at one end, wherein the side walls of the bag comprise a desiccant material (see column 3, lines 28-57). which defines at least a portion of the inner surface of each side wall. Duncan and Williams et al. each disclose a moisture impervious bag (10; C) including a substantially transparent material (15; 13) substantially impervious to moisture and a moisture indicating material (16; 12) mounted within the bag adjacent to the transparent material. To modify the bag of Neteler employing the moisture indicator structure of either one of Duncan and Williams et al. would have been obvious in order to provide an observer with visual indication of the moisture condition of the interior of the bag.

As to claim 3, Neteler discloses silica as the desiccant material, and official notice is taken that silica gel has long been recognized as a desiccating material used in packaging.

As to claims 4 and 5, see column 2, lines 49-62 of Neteler.

As to claim 6, Duncan and Williams et al. each disclose the transparent material as a moisture barrier film.

As to claims 7 and 8, Neteler discloses the bag being for an electronic device (see column 1, lines 16-20).

As to claim 8, Duncan discloses semiconductor devices (column 1, lines 11-26).

As to claim 15, Williams et al. disclose three moisture level indicators.

As to claims 21-23, the inner porous layer of Neteler impregnated with desiccant comprises a desiccant layer, the inner layer, by applicant's definition of an inner laminate layer comprising a bag in and of itself.

6. Claims 9-14 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Carbonneau (5,791,485) in view of Duncan. Claims 9-13, 15 and 17-18 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Carbonneau in view of Williams et al.. Carbonneau discloses a bag (10) comprising side walls substantially impervious to moisture and having an opening (at 43) at one end, wherein the side walls of the bag comprise a desiccant material disposed in an inner porous bag (20). Duncan and Williams et al. each disclose a moisture impervious bag (10; C) including a substantially transparent material (15; 13) substantially impervious to moisture and a moisture indicating material (16; 12) mounted within the bag adjacent to the transparent material. To modify the bag of Carbonneau employing the moisture indicator structure of either one of Duncan and Williams et al. would have been obvious in order to provide an observer with visual indication of the moisture condition of the interior of the bag.

As to claims 10 and 18, official notice is taken that silica gel has long been recognized as a desiccating material used in packaging.

As to claims 11 and 12, see column 3, lines 63 through column 4, line 50 of Carbonneau.

As to claim 13, Duncan and Williams et al. each disclose the transparent material as a moisture barrier film.

As to claim 14, Duncan discloses semiconductor devices (column 1, lines 11-26).

As to claim 15, Williams et al. disclose three moisture level indicators.

7. Claim 16 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the art applied against claim 15 above and further in view of Hu et al. (3,768,976). Hu et al. discloses an indicator including word directions to instruct a user what to do by the indication. To modify the numerical indication of Williams et al. employing word direction as taught by Hu et al. would have been obvious in order to instruct a user what to do. Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004).

8. Applicant's arguments filed October 10, 2006 have been fully considered but they are not persuasive. Upon reconsideration, and explanation that applicants' "inner bag" can comprise a laminate layer, the restriction requirement has been dropped.

9. With respect to Duncan and the 102 rejection, the examiner does not find applicants' argument that the integration of a moisture indicating material and a desiccant material in the same bag as simply not being known prior to applicants' filing to be contrary to the disclosure of Duncan, as well as Williams et al.. Applicants argue that the term "mounted" means other than its common usage, which is "joined to", and not limited to sealed to or unremovably fixed or unmovably fixed thereto, as applicants' now desire to interpret the term. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). There is no express recitation that "mounted" as claimed intends a more limited meaning than "joined". The prior art shows the moisture indicating material mounted within the bag to a side wall of the bag as much as claimed.

With respect to the combinations of Neteler and Carbonneau with Duncan and Williams et al., applicants argue that each reference does not disclose each of the claimed features. Applicants' arguments against the references individually are not convincing, as one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the employed references are nonanalogous art by virtue of their classification, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, each of Neteler, Carbonneau, Duncan and Williams et al. pertain to bags specialized to contain electronic components, where moisture absorbing and indication have been provided by the bags.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Friday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPG



Bryon P. Gehman  
Primary Examiner  
Art Unit 3728